Remarks

This paper is a response to a non-final Office action mailed January 12, 2005.

Claim 24 and 25 have been amended to eliminate redundant use of the word "the" in line 14 of each of those claims. Claims 22 and 25 have been amended to specifically indicate that controls are transmitted toward the application being profiled over a first connection while application execution data is transmitted toward a remote profiling agent over a second connection. No changes, other than those just noted, are being made in the claims.

Claim 1 stands rejected under 35 USC 103(a) over a hypothetical combination of the teachings of US Patent 6,457,142 - Klemm et al (Klemm), the teachings of US Patent 6,356,559 - Doucette et al (Doucette), and the teachings of US Patent 6,385,661 - Guthrie et al (Guthrie). Claim 1, as now written, is basically original claim 4 recast in independent form.

In an earlier Office action, claim 4 was rejected over a hypothetical combination of Klemm and Doucette. That action acknowledged that Klemm did not teach switching between synchronous and asynchronous transmission of data and attempted to remedy this admitted deficiency by citation of Doucette.

As noted in a response to the earlier Office action, one problem with the hypothetical combination is that the Klemm environment and the Doucette environment are so radically different that one of ordinary skill in the art would not only <u>not</u> think of trying to graft the synchronous/asynchronous capabilities of Doucette onto Klemm but almost certainly would not know how to accomplish it if he or she thought of it.

As noted in the earlier response, Klemm describes a point-to-point environment where the two end points of a connection establish synchronous or asynchronous modes of operation to control the exchange of data beween the end points. Doucette describes a ring architecture environment in which both synchronous and asynchronous data is passed from one module to the next in the ring in a single direction. Tokens are passed from one module to the next along the ring to permit the changes between synchronous and asynchronous modes of data passing.

For a 35 USC 103 rejection to be proper, (1) something in the references themselves must suggest the combination and (2) the combination itself must be implementable by one of <u>ordinary</u> skill in the art. The proposed combination of Klemm and Doucette satisfied neither of these tests.

The current Office action attempts to overcome the deficiencies of Klemm and Doucette by throwing Guthrie into the mix. The problem with this attempt is that Guthrie, like Klemm, describes a point-to-point system and contains nothing that suggests why it would have been obvious to one of ordinary skill in the art to meld the components of a point-to-point system (as taught by Klemm and Guthrie) with the components of a ring system (as taught by Doucette).

But even if it is assumed that one of ordinary skill in the art would see some reason to combine the teachings of Klemm, Guthrie and Doucette, the end result would still not be the apparatus defined by claim 1. Claim 1 defines an apparatus in which the apparatus receives controls from a profiling agent on a remote system and responds to one of those controls by selectively switching between synchronous and asynchronous transmission of application execution data to the remote profiling agent.

None of the cited references shows selective switching between types of data based on a control received from a remote profiling agent. Doucette mentions transmission of synchronous

and asynchronous data packets. However, Doucette does not show selectively switching between different types of data packets based on controls received from a remote system.

What Doucette does show that both synchronous and asynchronous data packets can be transmitted in different parts of a window that is long enough to assure that all pending synchronous data packets are transmitted in the "front end" of the window. Once all pending synchronous data packets are included in the window's front end, any slots open at the back end of the same window can be used for the transport of asynchronous data packets.

A switch between sending of synchronous data packets and asynchronous data packets does not happen because a control is received from a remote profiling agent. It happens because the sending system runs out of synchronous data packets to send and can begin to accommodate asynchronous data packets.

Thus, even if a hypothetical combination of Klemm, Doucette and Guthrie were appropriate, which it isn't for the reasons noted above, that combination would still not be the invention defined by claim 1.

As noted in the Office action, claim 24 is a method analog of claim 1. As such, it should be considered patentable for the same reasons that claim 1 is patentable.

Claims 22 and 25 stand rejected under 35 USC 103(a) over a hypothetical combination of Klemm and Guthrie further in view of US Patent 6,202,085 - Benson et al (Benson). Benson is cited for supposedly showing the use of two different connections to transport controls and application execution data. The Office action specifically mentions connections 36 and 57 in Figure 2 in the Benson patent.

Connections 36 and 57 both carry data in the same direction; that is, toward a collector/data collector component. These two connections clearly cannot satisfy the requirement that controls flow on one connection toward an application being profiled while application execution data flows from the application being profiled on another connection.

The rejection of claims 22 and 25 over the hypothetical combination of Klemm, Guthrie and Benson is improper and should be withdrawn.
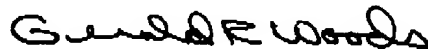
Claim 23 is again rejected under 35 USC 103(a) over Klemm in view of Doucette and further in view of US patent 6,574,675 - Swenson. The reasons why any proposed combination of Klemm and Doucette are improper have already been provided. The Swenson patent is not being cited as supposedly overcoming the deficiency of the proposed combination, which it doesn't. Swenson is cited for teaching a synchronous communication interface. Even if Swenson teaches a synchronous communication interface, it does not teach switching to such an interface if a synchronous event is recorded.

Any rejection of claim 23 over any possible combination of Klemm, Doucette and Swenson is improper and should be withdrawn.

PATENT
IBM Docket No. GB9-2000-0047US1

It is submitted that all claims in this application define patentable subject matter over the art of record. It is further submitted that the specification and drawings satisfy all statutory requirements. Therefore, it is believed that this application is in condition for allowance.

Respectfully Submitted,

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